

REMARKS

In the Office Action, the Examiner rejected claims 1-4, 6-8, 34-53, 55, 56, and 58-64 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,853,713 to Fobert et al. ("Fobert"), in view of U.S. Patent No. 6,687,362 to Lindquist et al. ("Lindquist"), and further in view of U.S. Patent Application Publication No. 2004/0052356 of McKinzie et al. ("McKinzie").¹

Claims 1-4, 6-8, 34-53, 55, 56, and 58-64 are currently pending with claims 1, 34, 53, 56, 59, and 62 being independent. Claims 5, 9-33, 54, and 57 were previously canceled without prejudice or disclaimer. Based on the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of the pending claims.

I. The § 103(a) Rejection of Claims 1-4, 6-8, 34-53, 55, 56, and 58-64 Based on Fobert, Lindquist, and McKinzie

Applicants respectfully traverse the § 103(a) rejection of claims 1-4, 6-8, 34-53, 55, 56, and 58-64 over Fobert in view of Lindquist, and further in view of McKinzie because a *prima facie* case of obviousness has not been established with respect to claims 1-4, 6-8, 34-53, 55, 56, and 58-64.

A. Claims 1-4, 6-8, 53, 55, 56, and 58

Independent claim 1 recites, among other things, "receiving, from a user, filter settings defining criteria for determining whether to add incoming calls to the address

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to the rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

book, the filter settings received from the user specifying one or more telephone numbers, locations, devices, or names for which associated contact-related information is not added to the address book.” Fobert, Lindquist, and McKinzie, taken alone or in combination, fail to teach or suggest at least the recited elements.

The Examiner correctly observed that “Forbert, nor Lindquist, . . . specifically disclose the filter settings received from the user specifying one or more telephone numbers, locations, devices, or names for which associated contact-related information is not added to the address book.” Office Action at 4. The Examiner, however, attempted to cure this deficiency of Fobert and Lindquist by relying on McKinzie. The Examiner asserted that “McKinzie . . . does disclose . . . for example, the address book of the customer may be flagged as corresponding to ‘trusted’ communications partners...the customer may indicate in their profile as to which communications partners are considered ‘trusted’ and to which communications partners are considered ‘non-trusted,’ and therefore, only allowing the information/profile of a ‘trusted’ communications partner to be updated/added to the address book when the ‘trusted’ communications partner’s information/profile has been altered/updated.” Office Action at 4. This is incorrect.

McKinzie discloses that “an address book entry may be flagged as corresponding to a ‘trusted’ communications partner, i.e., a communication partner that is given special priority and privileges with respect to communications with the customers.” McKinzie, ¶ [0040]. Because an entry that is already in the address book is being flagged in McKinzie, the flag of McKinzie has nothing to do with “filter settings defining criteria for determining whether to add incoming calls to the address book, the filter settings

received from the user specifying one or more telephone numbers, locations, devices, or names for which associated contact-related information is not added to the address book,” as recited in independent claim 1. Instead, the flag of McKinzie provides “information relating to routing rules for contacting a communication partner” by flagging “a communications partner [among other address book entries] that is given special priority and privileges with respect to communications with the customer.” McKinzie, ¶ [0040]. For at least these reasons, McKinzie fails to cure the deficiencies of Fobert and Lindquist.

In view of the above-noted deficiencies of the Fobert, Lindquist, and McKinzie references, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 1. Also in view of those deficiencies, no combination of the applied references can possibly yield claim 1, nor could claim 1 have been predictable from the applied references. Further in view of those deficiencies, there would have been no motivation for one of ordinary skill in the art to modify the teachings of the references to achieve Applicants’ claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 53, and 56, although of different scope, recite elements that are similar to those discussed above with respect to independent claim 1. For reasons similar to those reasons set forth above with respect to independent claim 1, a *prima*

facie case of obviousness has not been established with respect to claims 53 and 56, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Dependent claims 2-4 and 6-8 depend from independent claim 1, and dependent claims 55 and 58 depend from independent claims 53 and 56, respectively. Because any claim that depends from a nonobvious claim is also nonobvious, Applicants request the withdrawal of the § 103(a) rejection of claims 2-4, 6-8, 55, and 58 at least by virtue of their dependence from claims 1, 53, or 56, as well as by virtue of their recitation of additional elements not taught or suggested by the cited references.

B. Claims 34-52 and 59-64

Independent claim 34 recites, among other things, “periodically updating the contact-related information stored in the address book, independently of communications between the user and the party.”

The Examiner correctly observed that “Fobert, or Lindquist . . . does not disclose periodically updating the contact-related information stored in the address book, independently of communications between the user and the party.” Office Action at 6. The Examiner, however, attempted to rely on McKinzie to cure this deficiency of Fobert and Lindquist.

Applicants submit that McKinzie cannot be relied as prior art under 35 U.S.C. § 103(a) for its alleged teachings of “periodically updating the contact-related information stored in the address book, independently of communications between the user and the party.” McKinzie was filed on September 18, 2002. The present application is a continuation in part of U.S. Patent Application No. 10/083,793, filed on February 27, 2002, which claims benefit of priority to, among others, U.S. Provisional

Application No. 60/276,505, which was filed on March 19, 2001. At least pages 48, 49, and 66 of Appendix to the provisional application disclose the subject matter of “periodically updating the contact-related information stored in the address book, independently of communications between the user and the party,” as recited in independent claim 34.

For at least the above reasons, the Office Action has failed to clearly articulate a reason why claim 34 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 34, and the rejection under 35 U.S.C. § 103(a) should be withdrawn

Independent claims 59, and 62, although of different scope, recite elements that are similar to those discussed above with respect to independent claim 34. For reasons similar to those reasons set forth above with respect to independent claim 34, a *prima facie* case of obviousness has not been established with respect to claims 59 and 62, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Dependent claims 35-52, 60-61, and 63-64 depend from independent claims 34, 59, and 62, respectively. Because any claim that depends from a nonobvious claim is also nonobvious, Applicants request the withdrawal of the § 103(a) rejection of claims 35-52, 60, 61, 63, and 64 at least by virtue of their dependence from claims 34, 59, or 62.

II. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 2, 2010

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